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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/976,431	10/12/2001	Louis B. Paludi	1095_001CON	1032

7590 06/18/2002

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EXAMINER

ENATSKY, AARON L

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/976,431

Applicant(s)

PALUDI, LOUIS B.

Examiner

Aaron L Enatsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1, 11-12, and 22 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant requires an array of frames arranged substantially in a prescribed arrangement or in a prescribed arrangement. It is unclear as to what the substantially prescribed or prescribed arrangement might comprise.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Okada '672. Okada teaches of a video game machine containing a library of a plurality of non-identical images, showing at least two images in a series where each image series depicts a different event (Fig. 1). As is old and well known in the art of gaming machines, the library of images displayed are time sequenced, where the first image will be identified before the second image, and subsequent images sequentially identified. Okada also teaches of an array of frames for displaying the two or more images, wherein the array can contain nine frames in three vertically

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oriented columns and three horizontal rows (Fig. 1). Winning conditions in an event are pre-defined as matching pre-defined images as is old and well known in the art. In the nine-frame array a second winning condition can be depicted as a diagonal image match (Fig. 1).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 4, 6, 8, 10-15, 17-22 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Roffman '568 (Hereinafter, Roff). Roff teaches a video slot machine, with fewer or more than three reels. As is old and well known in the art, the reels comprise a series of identical and non-identical images defining a library, where each turn on a slot machine produces a different event (8:19-44). Roff also teaches an arrangement of a plurality of frames for displaying video images to define an event (Fig. 3A), the video slot machine game embodies various different sport themes of any type including football (7:57-67), and the video slot machines incorporate game features based upon associated theme (8:1-18).

In regard to the provision of a second game stemming from a first game, Roff discloses a first and second payout scheme which are directly linked to different winning conditions of different games (1:66-2:14).

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In regard to the secondary winning condition comprising a football scoring play, Roff teaches that if a player has scored a touchdown and no quarterback is assigned to the player's team, then the player becomes quarterback and a new game is then configured where the second winning condition differing from the initial winning condition lies in that a quarterback must be assigned to win the ensuing game/payout (12:19-26).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roff. Roff teaches the claimed limitation as mentioned above, but does not specifically mention a game with an associated race activity. However Roff does teach that a video slot game can comprise any sport (7:65-66). As Roff teaches of a variety of sport games including the provision of any type of sport game, it would have been obvious to one of ordinary skill in the art at the time the invention was made to vary the sport theme to include a race game.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Paludi '123, discloses a time sequenced image game substantially directed to a football game.

Seelig et al. '603, discloses a slot machine in combination with a horse or a car racing game.

Lermusiaux '855, discloses a wagering game using a football theme to determine player outcomes.

Luciano '980, discloses a second game dependent on winning a first wagering game.

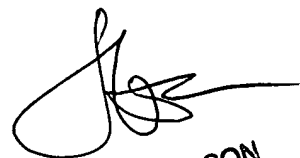
Mayeroff '483, discloses a second game dependent on winning a first game where the second game is different from the first game.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron L Enatsky whose telephone number is 703-305-3525. The examiner can normally be reached on 8:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Valencia Martin-Wallace can be reached on 703-308-4119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-9302 for regular communications and 703-746-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ale
June 12, 2002


JESSICA HARRISON
PRIMARY EXAMINER